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In re Application of
KIM, TAE HONG :
Application No.: 10/585,602 :
PCT No.: PCT/KR05/00134 : DECISION ON PETITION
Int. Filing Date: 14 January 2005 :
Priority Date: 15 January 2004 :
Attorney Docket No.: 05-507-B :
For: APPARATUS AND METHOD FOR
DUALIZING AN ASYNCHRONOUS
TRANSFER MODE (ATM) ROUTER IN
A CDMA 2000 SYSTEM

This decision is in response to applicant's "Petition under 37 CFR 1.47(b) By Person Having Proprietary Interest to File Application on Behalf of Inventor Who We Have Been Unable to Locate" filed 20 June 2007 to accept the application without the signature of inventor, Tae Hong Kim. The petition fee has been submitted.

BACKGROUND

On 14 January 2005, applicant filed international application PCT/KR05/00134 which claimed a priority date of 15 January 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 01 September 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 15 August 2006.

On 11 July 2006, applicant filed a transmittal for entry into the national stage in the United States, which accompanied by, *inter alia*: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a copy of the international search report.

On 16 March 2007, the United States Designated/Elected Office mailed "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required.

On 20 June 2007, applicant filed the present petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Items (1); (3); (4) and (6) under 37 CFR 1.47(b) have been satisfied.

Regarding item (2) above, petitioner states that Tae Hong Kim cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

A review of the present petition reveals that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventor, Tae Hong Kim. No documentary evidence to support the attempt(s) was provided with the declaration. It is noted that the "Declaration in Support of Petition under 37 CFR 1.47(b) . . . signed by Joo-Young Kim" was not included with the present petition.

Concerning item (5), petitioner has not demonstrated that applicant has a propriety

interest in the invention. It is noted that the "Memorandum of Law in Support of Petition under 37 CFR 1.47(b)... signed by Joo-Young Kim" was not included with the present petition.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Tae Hong Kim under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to:
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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